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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,910	06/04/2001	Allan Williams	P-001	2026
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			<div>EXAMINER HILLERY, NATHAN</div>	
			<div>ART UNIT 2176</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 08/02/2007</div>	<div>DELIVERY MODE PAPER</div>

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/871,910
Filing Date: June 04, 2001
Appellant(s): WILLIAMS ET AL.

Victoria Donnelly
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/12/07 appealing from the Office action
mailed 1/12/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 12, 24, 46 and 47 are rejected under 35 USC 101 as directed to non-statutory subject matter.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Claims 1, 2, 5, 7 – 16, 19, 21 – 27, 37 – 40, 43, 46, 47, 51 and 52 under 35 USC 102(e) as being anticipated. Claims 53 – 56 under 35 USC 103(a) as being unpatentable.

GROUND OF REJECTION NOT ON REVIEW .

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief. Claims 54 – 56 are rejected under 35 USC 112, second paragraph, as being indefinite.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12, 24, 46 and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention amounts to nonfunctional descriptive data stored in memory. Because the claims simply set forth mere arrangements and/or compilations of data in memory, the claimed invention is non-statutory.

(10) Response to Argument

Appellant argues that claims 12, 24 and 46 are patentable subject matter under 35 USC 101 because several patents have issued claiming an electronic document per se and electronic documents are not prohibited from being patented in the MPEP (p 14).

The Office disagrees.

First, the Office will not comment on the validity of any issued patent. Second, it should be understood that computer data related products are classified into one of two groups, either functional descriptive material or non-functional descriptive material. In this case, the latter is true.

A derivative patent document is non-functional descriptive material because it is not executable and imparts no functionality even in conjunction with a computer. By definition, non-functional descriptive material per se is an abstract idea, and therefore is not statutory. Further, non-functional descriptive material is not statutory even if in combination with a physical medium. Consequently, no useful, concrete or tangible result is produced since there is no functionality.

Examples of non-functional descriptive material are music, literature, art, photographs, data formats, frames or packets absent claimed structure that imparts functionality, a data base per se (i.e., just the software component or arrangement of data), mere arrangements of facts or compilations of data.

These examples are merely stored to be read or outputted by a computer without any functional interrelationship with the computer, and thus they do not impart any functionality to the computer. That is, they are not computer components. Again,

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consider In re Lowry, the data structure functioned as a computer component and increased computing efficiency.

Basis for the above reasoning may be found in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, which states that nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. § 101. Certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture or composition of matter (Annex IV (b)).

Furthermore, when nonfunctional descriptive material is recorded on some computer-readable medium, in a computer, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”) (Annex IV).

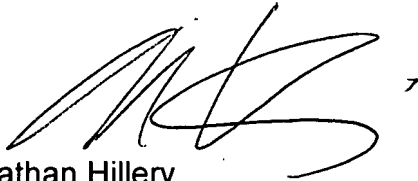
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Nathan Hillery

Conferees:

/Doug Hutton/
Supervisory Primary Examiner
Art Unit 2176

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